

REMARKS

Claims 1-3 and 5-10 are pending in the present application. Claim 4 was canceled; claims 1-3, 7, and 10 were amended; and no claims were added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The examiner has rejected claims 1-4, 7 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In rejecting claims 1-4, 7, and 10, the examiner states:

The phrase "EVOH" in claims 2 -4, 7 and 10 is unclear, which render the claims vague and indefinite. The abbreviation "EVOH" needs to be written out to its full meaning, ethylene-vinyl alcohol.

(Office Action dated August 16, 2002, p. 2).

Claims 1-3, 7, and 10 have been amended as requested by the examiner to spell out the abbreviation "EVOH". No change in scope is intended or believed to have been made by such amendments. Claim 4 has been cancelled.

In rejecting claims 3 and 10, the examiner states:

The phrase "approximately 0.1 mils thick" in claims 3 and 10 is unclear, which render the claims vague and indefinite. The word "approximately" makes the claim indefinite since the layer can be greater or less than 0.1 mils.

(Office Action dated August 16, 2002, p. 2).

The mere fact that the "layer can be greater or less than 0.1 mils" does not make claims 3 or 10 indefinite. The standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994). Determining whether a claim is indefinite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. *Credle v. Bond*, 25 F.3d 1566, 1576, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The claim is not indefinite if one skilled in the art would have no particular difficulty in determining whether "the ethylene-vinyl alcohol layer is approximately 0.1 mil

“thick” element has been implemented. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 U.S.P.Q.2d 1754, 1759 (Fed. Cir. 1994). Because Applicant’s invention does not reside in a particular number as the cutoff between the invention and the prior art, a numerical cut-off need not be specified. *In re Marosi*, 710 F.2d 799, 802-03, 218 U.S.P.Q. 289, 292 (Fed. Cir. 1983). Therefore, “approximately 0.1 mils thick” is not indefinite and the examiner’s rejection under 35 U.S.C. § 112, second paragraph is improper.

Therefore, the rejection of claims 1-3, 7, and 10 under 35 U.S.C. § 112, first paragraph has been overcome.

II. 35 U.S.C. § 102, Anticipation

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

A. Woods et al. (Claims 1-3)

The examiner has rejected claims 1-3 under 35 U.S.C. § 102(B) as being anticipated by Wood et al. (USPN 5,883,161). This rejection is respectfully traversed.

In rejecting claims 1-3, the examiner states:

Wood et al. discloses a film made from ethylene vinyl alcohol (Column 2, lines 39-60) with a thickness between 0.1 mm and 20 mm (Column 7, lines 25- 44) used as a barrier layer in a sealed container for a dry food product (Column 14, lines 40- 47). (Office Action dated August 16, 2002, p. 3).

Contrary to the examiner’s assertion, Wood et al. does not disclose a “thin sheet of ethylene-vinyl alcohol film as an interior surface of the container.” Column 7, lines 25-44 of Wood et al. refer to a film of thermoplastic resin. A list of thermoplastic materials is provided by Wood et al. at column 8, line 18-53. Ethylene vinyl alcohol is not contained in the list. Therefore, claim 1 is not anticipated by Wood et al.

Furthermore, Wood et al. does not teach or suggest that “the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film” as recited in claim 1 as amended in the present application.

Similarly, since claims 2-3 depend from claim 1, and include all limitations of claim 1 as well as other claim limitations, claims 2-3 are not anticipated by Wood et al.

B. Bettle, III et al. (Claims 1-3)

Claims 1- 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bettle, III et al. (USPN 4,977,004).

In rejecting claims 1-3, the examiner states:

Bettle, III et al. discloses a food container (Column 1, lines 12- 14) for use with a variety of foods (Column 3, line 67 to Column 4, line 2) made with an inner layer of ethylene vinyl alcohol (Figure 2, #20 and Column 7, lines 30- 33) that is in contact with the food item (Column 2, lines 51- 54) with a thickness of 0.1 mm(Column 5, lines 29- 31). The container is sealed through heat sealing (Column 8, lines 8-9).

(Office Action dated August 16, 2002, p. 3).

Claim 1 has been amended to include the additional limitation that “the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film.” Such a limitation is not taught or suggested by Bettle, III et al. Therefore, Bettle, III et al. does not anticipate claim 1 as amended. For similar reasons, Bettle, III et al. does not anticipate claim 2 of the present application.

C. Pezzoli et al. (Claims 1-2)

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Pezzoli et al. (USPN 5,491,011).

In rejecting claims 1-2, the examiner states:

Pezzoli et al. discloses a barrier layer of ethylene vinyl alcohol (Column 3, lines 54- 60) with a thickness between 0.23 to 0.75 mm (Column 4, lines 3 -5). The film is used as part of a bag that is sealed for dry food products such as pet foods and animal feeds (Column 4, lines 41-52).

(Office Action dated August 16, 2002, p. 4).

Claim 1 has been amended to include the additional limitation that “the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film.” Such a limitation is not

taught or suggested by Pezzoli. Therefore, Pezzoli does not anticipate claim 1 as amended. For similar reasons, Pezzoli does not anticipate claim 2 of the present application.

D. Vadhar (Claims 1-2)

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Vadhar (USPN 6,333,061).

In rejecting claims 1-2, the examiner states:

Vadhar discloses a multi-layer sealed (Column 6, lines 13- 21) article formed from four layers of film (Column 2, lines 43 -44), where in 85 % of the film is formed from ethylene vinyl alcohol (Column 2, lines 62- 67) used to package dry pet food (Column 1, lines 14- 16). The film has a total thickness of 2 mm (Column 27, lines 14- 15), giving the ethylene vinyl alcohol a thickness of 0.5 mm. (Office Action dated August 16, 2002, p. 4).

Claim 1 has been amended to include the additional limitation that “the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film.” Such a limitation is not taught or suggested by Vadhar. Therefore, Vadhar does not anticipate claim 1 as amended. For similar reasons, Vadhar does not anticipate claim 2 of the present application.

E. Ramirez (Claims 1-2)

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramirez (USPN 6,214,392).

In rejecting claims 1-2, the examiner states:

Ramirez discloses a package formed of films with an individual thickness of 0.25 mm or less (Column 6, lines 39-42) that are sealed (Column 6, lines 47-56) to form a package for dry food products (Column 2, lines 32-38). One of the films is a barrier layer made from ethylene vinyl alcohol (Column 7, lines 32-41). (Office Action dated August 16, 2002, pp. 4-5).

Claim 1 has been amended to include the additional limitation that “the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film.” Such a limitation is not taught or suggested by Ramirez. Therefore, Ramirez does not anticipate claim 1 as amended. For similar reasons, Ramirez does not anticipate claim 2 of the present application.

F. Anticipation Conclusion

Therefore, the rejection of claims 1-3 under 35 U.S.C. § 102 has been overcome.

III. 35 U.S.C. § 103, Obviousness

The examiner has rejected claims 4-10 under 35 U.S.C. § 103(a) as being unpatentable over Bettle, III et al. in view of Jones et al. (USPN 6,063,414). This rejection is respectfully traversed.

In rejecting claims 4-10 the examiner states:

Bettle, III et al. discloses a food container (Column 1, lines 12- 14) for use with a variety of foods (Column 3, line 67 to Column 4, line 2) made with an inner layer of ethylene vinyl alcohol (Figure 2, #20 and Column 7, lines 30- 33) that is in contact with the food item (Column 2, lines 51- 54) with a thickness of 0.1 mm (Column 5, lines 29- 31). The container is sealed through heat sealing (Column 8, lines 8-9). However, Bettle, III et al. fails to disclose the dry food product acting as a desiccant to draw moisture away from the ethylene vinyl alcohol layer and the dry food product comprising a water activity of less than 0.6 or 0.4 upon the sealing step.

Jones et al. teaches dry pet food with a water activity 0.7 or less (Column 11, lines 16 - 17) that acts as a desiccant since water binds to the soluble fiber material (Column 5, lines 3- 6) in a polymer (Column 11, lines 7- 9) container of gas impermeable materials (Column 5, lines 1-2) for the purpose of packaging food that does not require preservatives or removal of oxygen to attain an increased shelf life, freshness and palatability of the dry food product.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a dry food product with a water activity 0.7 or less to act as a desiccant in a container in Bettle, III et al. in order to package food that does not require preservatives or removal of oxygen to attain an increased shelf life, freshness and palatability of the dry food product as taught by Jones et al.

(Office Action dated August 16, 2002, pp. 5-6).

A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a *prima facie* case. Where the claims require that an element serve a specific purpose, the fact that a similar element was used for another purpose in the prior art or that the claimed element has a prior art attribute does not establish a *prima facie* case of obviousness. *In re Wright*, 848 F.2d 1216, 6 U.S.P.Q.2d 1959, (Fed. Cir. 1988).

In combining Bettle, III et al. with Jones, the examiner has not pointed to any teaching in either reference suggesting such a modification, but rather has merely asserted that it would have been obvious. Such an assertion is insufficient to meet the examiner's burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). However, in the instant case, the examiner has merely found two disparate references containing between the two of them every element of the claimed invention. However, the inquiry is not whether each claimed element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art.

Jones et al. is motivated by a need to prevent microbial growth in and oxidation of pet food without resorting to vacuum packaging. (See Jones et al., col. 3, lines 5-25). However, Jones et al. shows no concern and fails to recognize a problem with ethyl vinyl alcohol films when exposed to water. Bettle, III et al. focuses on the problem of oxygen permeability of barrier films in low cost food packages. Neither of these references observes a problem with ethyl vinyl alcohol related to contact with water or a need to solve this problem. Therefore, there is not motivation to combine these two references.

Furthermore, Bettle, III et al. issued on December 11, 1990 and Jones et al. was not filed August 18, 1997. However, even after almost seven years, Jones et al. did not recognize a need to combine the teachings of the Jones et al. patent with the teachings of the Bettle, III et al. patent. Thus, even with the existence of the Bettle, III et al. teachings and the long known problem with ethyl vinyl alcohol with regard to losing its effectiveness as an oxygen barrier when it comes in contact with moisture, Jones et al. was not motivated to even suggest combining its teachings with Bettle's to overcome this problem.

Thus, it seems that perhaps the examiner's rejection is based more on hindsight than that of one of ordinary skill in the art at the time of the applicant's invention. As one court noted,

The invention all admired, and each how he
To be the inventor missed; so easy it seemed,
Once found, which yet unfound most would have thought,
Impossible!

Gillette Co. v. S.C. Johnson & Son, Inc., 919 F.2d 720, 726, 16 U.S.P.Q.2d 1923, 1929 (Fed. Cir. 1990), quoting Milton, *Paradise Lost*, Part VI, l. 478-501.

Thus, since there is no motivation to combine Bettle, III et al. with Jones et al., claims 5-10 of the present application are not rendered obvious.

Therefore, the rejection of claims 5-10 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over Wood et al., Bettle, III et al., Pezzoli et al., Vadhar, Ramirez, and Jones et al. and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application. The Commissioner is hereby authorized to charge any additional payment that may be due or credit any overpayment to Deposit Account No. 50-0392.

Respectfully submitted,



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APPENDIX

REDACTED CLAIMS:

A redacted version of the amended claims is as follows:

1. (Once Amended) A method for making a plastic dry food container, said method comprising the steps of:
 - a) forming a thin sheet of [EVOH] ethylene vinyl alcohol film as an interior surface of the container;
 - b) placing a dry food product within said container, wherein the dry food product acts as a desiccant to draw moisture away from the ethylene vinyl alcohol film; and
 - c) sealing said container.
2. (Once Amended) The method of claim 1 wherein the [EVOH] ethylene vinyl alcohol layer is less than 0.5 mils thick.
3. (Once Amended) The method of claim 1 wherein the [EVOH] ethylene vinyl alcohol layer is approximately 0.1 mils thick.
7. (Once Amended) A multi-layer plastic container comprising:
an interior layer of [EVOH] ethylene vinyl alcohol, said layer of [EVOH] ethylene vinyl alcohol being less than 0.5 mils thick;
a dry food product having desiccant properties sealed within said container.
10. (Once Amended) The multi-layer plastic container of claim 7 wherein said layer of [EVOH] ethylene vinyl alcohol is approximately 0.1 mils thick.